

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS: Yves Leaute et al. EXAMINER: RYAN J. JAKOVAC
SERIAL NO.: 10/801,043 ART UNIT: 2445
FILED: March 15, 2004 DOCKET NO: 2003P04011 US01
CONFIRMATION NO.: 1244
FOR: META-SEARCH WEB SERVICE-BASED ARCHITECTURE
FOR PEER-TO-PEER COLLABORATION AND VOICE-OVER-
IP

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P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Examiner:

This paper is being filed with a Notice of Appeal Form (PTO/SB/31), and a Pre-Appeal Brief Request For Review Form (PTO/SB/33).

REMARKS

Please consider the following reasons for this Pre-Appeal Brief Request For Review. Claims 1-7, 9-11, 13, 14, 16-23, 26, 28, and 29 are pending and stand rejected in the above-referenced application.

REJECTIONS UNDER 35 U.S.C. § 103

Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness with respect to the pending claims.

Claims 1-4, 6-7, 9-11, 13-14, 17, 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over AAPA in view of U.S. Patent Publication 20040006708 to Mukherjee.

AAPA and Mukherjee fail to disclose or suggest *each identity file is an Extensible Markup Language (XML) file that is posted in a public shared directory on an end-user device and accessible using a P2P protocol and each identity file includes a tag including information for a VOIP process of the end-user to enable the VOIP session*

between the seeker device and the end-user, as recited in claim 1.

Indeed, the Examiner acknowledges that AAPA and Mukherjee fail to disclose the above features. For example, the Examiner states (in p. 7, lines 1-2 of the Final Action) "AAPA and Mukherjee do not disclose wherein each identify file includes a tag including information for a VOIP process of the end-user to enable the VOIP session between the seeker device and the end-user".

The Examiner instead contends that the above elements are either inherent or obvious to VOIP over a P2P network. For examples, the Examiner states (in p. 3, lines 13-17 of the Final Action) the following:

If not inherent these elements are obvious in view of AAPA and Mukherjee. AAPA on p. 6 discloses that it is well known to engage in a call (i.e., VOIP) once an end user is located. Engaging in a VOIP call once an end user is located on a P2P network suggests including a tag representing information that the user is VOIP capable or registered to use VOIP services as part of an identity file.

Applicants disagree with the Examiner's premise that engaging in VOIP call on a P2P network inherently suggests use of an identify file having an XML format that is posted in a public shared directory accessible using a P2P protocol, where the file includes a tag representing that the user is VOIP capable or registered to use VOIP services. For example, a device of a user engaged in VOIP may not support XML and even if it does support XML, there is no requirement in conventional VOIP that a check be performed of an identify file of an XML format on a public shared directory for a tag specifying whether the user is VOIP capable or registered VOIP to use VOIP. Indeed, a device could instead engage in a VOIP session by broadcasting its VOIP characteristics in a message, without storing such in a tag of an identify file of an XML format on a public shared directory accessible via a P2P protocol.

As stated in MPEP 2112, "[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art."

The Examiner has provided no basis in fact and/or technical reasoning to the determination that VOIP over a P2P network inherently require files of an XML format be stored in a public directory accessible via a P2P protocol and including a tag specifying the user is VOIP capable or registered to use VOIP services.

Additionally, as stated in MPEP 2143.03 (C), "[i]f the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding". The Examiner has provided no such affidavit.

The Examiner next states (in p. 3, lines 17-18) the following:

For example, it would have been obvious to provide information indicating that the user is VoIP capable or is registered to use VoIP services as part of the identity file.

The above sentence is conclusory because the Examiner fails to provide any facts to support why it would have been obvious to provide information indicating that the user is VoIP capable or is registered to use VoIP services as part of an identity file, much less providing such information in a tag of an identity file in an XML format on a public shared directory accessible via a P2P protocol.

As stated in MPEP 2141 "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."

Here, since the Examiner merely concludes it would have been obvious to provide information indicating that the user is VoIP capable or is registered to use VoIP services as part of the identity file without any support, the Examiner has failed to articulate reasoning with some rational underpinning to support the legal conclusion of obviousness of claim 1.

For at least the foregoing reasons, there are clear errors in the Examiner's rejection of claim 1 under 35 U.S.C. 103(a).

For at least similar reasons to claim 1 there are clear errors in the Examiner's rejection of claim 28 under 35 U.S.C. 103(a). For example, claim 28 recites *wherein each identity file is an Extensible Markup Language (XML) file that is posted in a public directory that is accessible using a P2P protocol, and at least one of the identity files includes a second tag including information for a VOIP process of the corresponding one of the collaborators to enable the VOIP session between the seeker device and the collaborators.*

AAPA and Mukherjee also fail to disclose or suggest *performing a search by the seeker device on a public shared directory of the P2P network for identity files having an Extensible Markup Language (XML) format that include a tag representing a name of*

a potential collaborator on the P2P network, and a tag representing a domain name of the collaborator, as recited in claim 10.

The Examiner states (in p.4, of the Final Action) the "AAPA clearly shows user names displayed within a user query" and "[p]roviding a domain name for a user is an obvious variation over the cited which shows user names and this does not comprises a patentably distinguishable feature over the cited art".

The Examiner suggests that FIG. 4 of application 60/455,483 (hereinafter referred to as '483 application) is part of the AAPA and that its listing of a user name along with a corresponding XML files (e.g., iTunes Music Library.xml and User crax0r10) suggests that a tag for the user name is present in the corresponding XML file.

However, FIG. 4 is not described in the '483 application as being prior art. Further, the users in FIG. 4 are not described in the '483 application as being derived from tags within the corresponding XML file. Indeed, user information for a corresponding XML file could have been acquired in various ways.

Moreover, it is believed that a domain name is not an obvious variation over a user name. The KSR case suggests that converting a mechanical pedal to an electronic pedal is an obvious variation partly because they still perform the same function (e.g., each is used to accelerate a car). However, a domain name is not an obvious variation over a user name since a user name provides a very different function from that of a domain name. For example, a user name identifies a user to a device to enable a user to logon to the device, whereas a domain name merely indicates one or more IP addresses. Indeed, unlike a domain name, a user name cannot be resolved to one or more IP addresses by a Domain Name System (DNS). Thus, it is believed that a domain name is not an obvious variation over a user name.

For at least the foregoing reasons, there are clear errors in the Examiner's rejection of claim 10 under 35 U.S.C. 103(a).

Further, there are clear errors in the Examiner's rejection of claims 2-4, 6-7, 9, 11 and 13-14 under 35 U.S.C. 103(a) at least by virtue of their dependence from their base claims.

AAPA and Mukherjee do not disclose or suggest, *the entry fields for entering names of collaborators, performing a search by the seeker device on the P2P network*

to determine identity files having filenames that include a corresponding name from the search entry fields, and initiating a VOIP session with the list of collaborators, as recited in claim 17. For example, as shown in p. 6 of the '483 application, if the name is John Smith, the file name includes both John and Smith (e.g., John.Smith.xml).

The AAPA is silent regarding naming files posted on a P2P network with names of potential collaborators for a VOIP session. While, Mukherjee teaches (in paragraph [0047]) a network access identifier (NAI) such as user_name@service_provider.com, Mukherjee fails to teach the NAI being used as filename, much less a filename of a file stored on a P2P network.

For at least the foregoing reasons, there are clear errors in the Examiner's rejection of claim 17.

Claims 5, 16, 18, 19-23, 26, and 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over AAPA, Mukherjee, and "A Semantic Web based Peer-to-Peer Service Registry Network" to Thaden.

The rejections of claims 5, 16, 18, 19-23, 26, and 29 are premised on reliance that AAPA and Mukherjee disclose or suggest base claims 1, 10, 17, and 28. However, claims 1, 10, 17, and 28 are not disclosed or suggested by AAPA and Mukherjee for at least the above described reasons. Further, the deficiencies of AAPA and Mukherjee in these regard are not cured by Thaden.

For at least the foregoing reasons, there are clear errors in the Examiner's rejection of claims 5, 16, 18, 19-23, 26, and 29 under 35 U.S.C. 103(a).

An early and favorable reconsideration is earnestly solicited.

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

2003P04011 US01

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on _____

Signature _____

Typed or printed name _____

Application Number

10/801,043

Filed

March 15, 2004

First Named Inventor

Leaute, et al.

Art Unit

2445

Examiner

Ryan J. Jakovac

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

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Registration number _____

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Registration number if acting under 37 CFR 1.34 _____

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July 2, 2010

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

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*Total of _____ forms are submitted.

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